

REMARKS

Reconsideration of this application is respectfully requested.

In the Official Action, the Examiner maintains the rejections of claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,554,980 to Hashimoto et al. (hereinafter "Hashimoto") in view of U.S. Patent No. 6,227,687 to Kahwaji (hereinafter "Kahwaji").

In response, Applicants again respectfully traverse the Examiner's rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below.

Hashimoto teaches a remote control unit for use with a controlled unit, such as a monitor. The remote control unit has a motion detector and a transmitter. The motion detector detects the motion of the remote control unit and transmits the same through the transmitter to the controlled unit. **A controller in the controlled unit receives the motion detection signals from the remote control unit and moves a cursor on a display screen accordingly to correspond with the detected movement of the remote control unit.**

Kahwaji teaches an interleaved illumination support. The support has a base and a wire coupled to the base. Beads are attached to the wire to fix leafs thereon which maintain the wire in tension. **The beads are disclosed as being solid objects, such as fishing weights, having a bore for stringing the same on the wire.**

In the Official Action, the Examiner continues to engage in a very fanciful interpretation of Hashimoto and Kahwaji to defeat the patentability of the claims. The Examiner argues that Hashimoto discloses all of the features of independent claims 1, 6, 12, 14, and 17 with the exception of the objects (or tokens) being beads connected by a wire, for

which he cites Kahwaji. Applicants again respectfully disagree with the Examiner's interpretation of both Hashimoto and Kahwaji.

With regard to Hashimoto, the same does not disclose or suggest the "at least two objects, each associated with a respective data set consisting of at least one datum" as recited in independent claim 1. Hashimoto further does not disclose or suggest, "a mechanically connected combination of tokens, each associated with a data set" as recited in independent claim 6. Hashimoto further does not disclose or suggest "tokens, each corresponding to a set of criteria pertaining selectively to a subset of said data" as recited in independent claim 12. Hashimoto still further does not disclose or suggest "encoding tokens with unique identifiers" and "storing an address on a communication station, said address pointing to a respective data set for each of said tokens" as is recited in independent claims 14 and 17.

With regard to Kahwaji, the same discloses simple solid beads strung on a wire, Kahwaji does not disclose or suggest the objects (or tokens) recited in the claims. Kahwaji also does not disclose where the at least two objects "are tokens connected by a chain, a wire, string, or filament" or wherein said at least two objects "are beads." The beads of Kahwaji are actual beads, not the objects or tokens having the recited features in independent claims 1, 6, 12, 14, or 17 as discussed above and having a form of a bead.

Thus, independent claims 1, 6, 12, 14, and 17 are not rendered obvious by the cited references because neither the Hashimoto patent, nor the Kahwaji patent, whether taken alone or in combination, teach or suggest the user interface, system or methods having the features described above. Accordingly, claims 1, 6, 12, 14, and 17 patentably distinguish over the prior art and are allowable. Claims 2-5, 7-11, 13, 15, 16, and 18, being dependent upon

claims 1, 6, 12, 14, and 17, are thus allowable therewith. Consequently, the Examiner is again respectfully requested to withdraw the rejection of claims 1-18 under 35 U.S.C. § 103(a).

In the Final Official Action, the Examiner responds to Applicant's previous arguments (Filed February 3, 2003) by simply stating that the teaching of the combination of Kahwaji with two beads (100) and Hashimoto as discussed above. The Examiner makes no specific response with regard to the deficiencies of both Hashimoto and Kahwaji outlined above and in the previous response. Applicants respectfully request that the Examiner treat the outlines deficiencies with more specificity.

Furthermore, assuming arguendo that the features of claims 1, 6, 12, 14, and 17 are shown in the combination of Kahwaji and Hashimoto, Applicants respectfully submit that there is no motivation or suggestion to combine Kahwaji with Hashimoto.

Recently the U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. § 103(a) (*In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir., July 15, 1998)). The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of the art. If such a rote indication could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for

rejection. To counter this potential weakness in the obviousness construct **the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them. This the Examiner has not done. The Examiner only states that it would be obvious "to utilize the teachings as taught by Kahwaji using tokens are beads in the system device as taught by Hashimoto et al. because this would allow the user adjusting the vertical height of each line source on the lamps and maintain the wire in tension" (see page 4 of the Final Official Action).

Applicants respectfully submit that the Examiner's reasoning is totally irrelevant to the present invention. The beads (or tokens or objects) of the present invention

are each associated with a respective data set consisting of at least one datum, for example beads 310, 312, 314, 340, 345, 350, 355, 363, and 367 in Figures 2A, 2B, and 3 of the present application. The beads interact with a controller (for example controller 320 in Figures 2A, 2B, and 3) through a transmission operatively associated with the beads. In an embodiment, the beads are interconnected by a filament, chain, string, or wire. As discussed above, Kahwaji teaches a lamp having a wire with interleaved leafs. Beads are attached to the wire to fix the leafs thereon which maintains the wire in tension. The beads are disclosed as being solid objects, such as fishing weights, having a bore for stringing the same on the wire. There is absolutely no suggestion or motivation for using the simple beads in the electronic device of Hasimoto or in any device other than a mechanical device. The Examiner argues that the combination would allow the user adjusting the vertical height of each line source on the lamps and maintain the wire in tension. These are objectives that are totally irrelevant to the present invention, which is directed to a user interface.

Thus, Applicants respectfully submit that the Examiner, without identifying a suggestion, motivation, or teaching for combining the references, has used impermissible hindsight to reject claims 1-19 under 35 U.S.C. § 103(a). To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

In light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, the applicant respectfully submits that the rejection for obviousness under 35 U.S.C. § 103(a) lack the requisite motivation and must be withdrawn.

In addition, Applicant respectfully submits that the Kahwaji reference is not proper because it is from a non-analogous art. To be considered analogous art, the references cited by the Examiner must be either in the same field as the invention or be reasonably pertinent to the problem faced by the inventor.¹ Applicant respectfully submits that neither of these requirements have been met in the present case.

With regard to the first prong of the non-analogous art test -- namely, whether a reference is within the field of the invention, the Federal Circuit has stated:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" -in other words, common sense- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.²

Thus, a case-by-case analysis must be made to determine if a person of ordinary skill would look to the fields of the references for a solution to the problem facing the inventor.³

In clarifying how to determine the second prong of the test -- namely, whether a reference is reasonably pertinent to the particular problem with which an inventor was involved, the Federal Circuit has stated that:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.⁴

¹ See, e.g., *In re Clay*, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992); *In re Paulsen*, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994); and *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ 2d 1767 (Fed. Cir. 1993).

² *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

³ Id. See also, *In re Wright*, 848 F.2d 1216, 6 USPQ 2d 1959, 1962 (Fed. Cir. 1988) ("[A]s with all section 103 decisions, judgement must be brought to bear based on the facts of each case.").

⁴ *In re Clay*, 23 USPQ 2d at 1060-1061.

With regard to the first prong of the non-analogous art test, and in view of the Federal Circuit's narrow view of what is in the same field of endeavor,⁵ it cannot be said that the Kahwaji reference is within the same field of endeavor as the present invention, which is directed to a user interface. The Kahwaji reference, which is directed to a lamp, is not even remotely related to a user interface. Thus, Applicants respectfully submit that the Kahwaji reference is not in the same field of endeavor as the present invention.

With regard to the second prong of the non-analogous test, Applicant respectfully submits that the Kahwaji reference is not reasonably pertinent to the particular problem with which the inventor of the present invention was involved.

As discussed above and at length in the specification, the present invention is directed to easily programming and customizing certain electronic devices, such as a computer. This is a very different problem then faced by the inventors of the Kahwaji reference. In Kahwaji, the problem faced by the inventor was in supporting a wire-line type of lamp. Thus, Kahwaji was not faced with the same problem as the inventor of the present invention. To paraphrase the words of the Federal Circuit, the matter with which the Kahwaji reference deals, logically would not have commended itself to the inventor's attention in considering their problem. Thus, since it is directed to different purposes, the inventors would accordingly have had no motivation or occasion to consider it.

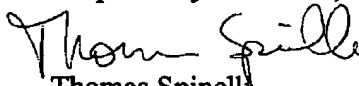
Accordingly, Applicant respectfully submits that at least the Kahwaji reference is not in the same field of endeavor as the present inventions, nor is it reasonably pertinent to

⁵ In *Wang Laboratories*, 26 USPQ 2d 1767, in which the present invention related to memory circuits and the cited reference referred to compact modular memories, the Federal Circuit held that the cited references were not in the same field of endeavor, stating that the reference "... is not in the same field of endeavor as the claimed subject matter merely because it relates to memories."

the particular problem with which the inventors of the present invention were involved. Consequently, the Examiner is respectfully requested to withdraw the Kahwaji reference, thereby rendering the 35 U.S.C. § 103(a) rejections of claims 1-19 moot.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,


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